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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,559	02/01/2001	Michael B. Marks	SC-1	2503

7590

06/30/2004

Brad I Golstein
Metro88
20755 Plummer Street
Chatsworth, CA 91311

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,559

Applicant(s)

MARKS ET AL.

Examiner

Arthur Duran

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

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phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

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affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1-14. At least one step of the body of the claims must explicitly utilize the technological arts. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (6,594,640) in view of Dedrick (5,724,521).

Claim 1, 5: Postrel discloses an incentive benefit program to encourage selected activities by users of a data network where a user is provided an opportunity to engage in the selected activity, and a benefit provider presents to the user an offer of compensation in return for the user electing to engage in the selected activity, wherein:

at least upon an initial opportunity to engage in the selected activity, the user instructs the benefit provider to assign the compensation to a pre-existing third party benefits program to which the user has previously joined (col 4, lines 5-30; Fig. 1; Fig. 4; Fig. 5; col 2, line 67-col 3, line 5); the user being identified to the benefit provider by the identity of the benefit account;

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the compensation comprising additions of value to the benefits account (col 4, lines 5-30).

Postrel further discloses the user utilizing a password (col 11, lines 61-66).

Postrel does not explicitly disclose the user remaining substantially anonymous with respect to the benefit provider.

However, Dedrick discloses providing benefits to a user for engaging in an activity (col 13, lines 53-64; Fig. 1) and the user remaining substantially anonymous with respect to the benefit provider (col 3, lines 50-55; col 11, lines 42-50).

Dedrick further discloses that the benefit provider has access to information about the user that is limited to the account number of the third party benefits program (col 3, lines 50-55; col 11, lines 42-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's user identity privacy to Postrel's user benefits program. One would have been motivated to do this in order to better maintain the security and privacy of Postrel's users.

Claim 2: Postrel and Dedrick disclose the incentive benefit program of claim 1. Postrel further discloses that the third party benefits account comprises at least one of: a frequent flier program, a video rental program or a grocery store discount program (Fig. 2; Fig. 4).

Claim 3: Postrel and Dedrick disclose the incentive benefit program of claim 1. Postrel further discloses that the third party benefits program is associated with a user by an account number (Fig. 2; Fig. 3), and that the user maintains a relationship with a third party that operates the third party benefit program whereby the third party has access to information about the user that is of inherent value (Fig. 4; Fig. 5, item 54);

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the inherent value comprising at least one of: an ability to directly contact the user, and an ability to gain monetarily from the user (Fig. 4, item 104; col 4, lines 24-31).

Claim 4: Postrel and Dedrick disclose the incentive benefit program of claim 3. Postrel further discloses that the inherently valuable information about the user comprises at least one of: an email address, a home address, a business address, a home telephone number, a business telephone number, a credit card number, a driver license number and a social security number (Fig. 5, item 54; col 10, lines 1-10).

Claim 6: Postrel and Dedrick disclose the incentive benefit program of claim 1. Postrel further discloses that the data network includes the Internet (col 5, lines 7-11).

Claim 7: Postrel and Dedrick disclose the incentive benefit program of claim 1. Postrel further discloses that the selected activity includes viewing advertisements provided by advertising providers on behalf of advertisers (col 2, lines 14-20; col 5, lines 11-16).

Claim 8: Postrel and Dedrick disclose the incentive benefit program of claim 7. Postrel further discloses that the advertising provider has been told by advertisers which advertisements to include in the benefits program (col 8, lines 4-17; col 5, lines 11-16; Fig. 4).

Claim 9: Postrel and Dedrick disclose the incentive benefit program of claim 7. Postrel further discloses that the advertising provider has access to the inherently valuable information about the user (col 8, lines 4-17; col 5, lines 11-16; col 7, lines 32-41; Fig. 4).

Claim 10: Postrel and Dedrick disclose the incentive benefit program of claim 1. Postrel further discloses that the benefit provider determines which third party benefits programs are available to the user for use with the incentive benefit program (Fig. 5, item 54, Merchant Offers).

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Claim 11: Postrel and Dedrick disclose the incentive benefit program of claim 7. Postrel further discloses that the advertiser determines which third party benefits programs are available to the user for use with the incentive benefit program (Fig. 5, item 54, Merchant Offers). Note that the benefits provider and the advertiser can be independent or the same entity (col 5, lines 11-16; col 2, lines 14-20).

Claim 12: Postrel and Dedrick disclose the incentive benefit program of claim 7. Postrel further discloses that the benefit provider and the advertising provider are independent entities (col 2, lines 45-65; Fig. 1). Note that in column 2, lines 45-65 the airline is the benefits provider and the partners are advertising providers. The airline provides the actual benefit where bonus miles can be utilized for free flights. The partners (such as the phone company in the example) do not provide a benefit, but rather only provide bonus miles that can be utilized with the benefit providing airline.

Claim 13: Postrel and Dedrick disclose the incentive benefit program of claim 7. Postrel further discloses that the benefit provider and the advertising provider are operated by a common entity (col 5, lines 11-16).

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (6,594,640) in view of Dedrick (5,724,521) and in further view of Kanter (5,537,214).

Claim 14: Postrel and Dedrick disclose the incentive program of claim 1.

Postrel does not explicitly disclose that a benefit incorporates a lottery mechanism.

However, Kanter discloses that a benefit incorporates a lottery mechanism (col 15, lines 36-44).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's benefit as a lottery to Postrel's benefits programs to users. One would have been motivated to do this in order to provide a benefit type that is attractive to some users.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Angles (5,933,811) discloses multiple sponsors and rewarding a user for certain activities;
- b. Eggleston (6,061,660) discloses multiple sponsors and rewarding a user for certain activities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
6/21/04